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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,359	02/05/2004	John C. Hill	511-007	8409

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EXAMINER

HOWARD, SHARON LEE

ART UNIT PAPER NUMBER

1615

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/774,359

Applicant(s)

HILL ET AL.

Examiner

Sharon L. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/24/05, 3/30/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Applicant's arguments with respect to claims 1-4,6,8-15,17-31 have been considered but are moot in view of the new grounds of rejection. Receipt of the request for continued examination (RCE) and the response and amendment filed on 3/3/05 and the change of correspondence address filed on 1/24/05 have been acknowledged.

### ***Status of the Claims***

Claims 1 and 31 have been currently amended. Claim 5 has been cancelled. Claims 1-4,6,8-15,17-31 are now pending in this application.

### ***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6,8-15,17-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (USPN 5,047,232).

The reference teaches topical compositions consisting of jojoba oil, lanolin oil, coconut oil, olive oil, liquid lanolin and cottonseed oil which are suitable cosmetic

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emollients (see col.3, lines 49-54). Kaplan teaches semi-solid cosmetic emollients which include hydrogenated lanolin, petrolatum, isopropyl lanolate, butyl myristate, cetyl myristate, cetyl alcohol and isocetyl lanolate (see col.4, lines 12-20). The compositions may also contain dyes which can be defined as colorants, perfumes and antioxidants (see col.5, lines 22-24).

The reference does not teach the particular temperature.

However, absent a showing in the criticality of the particular temperature, there are no unexpected results since the prior art reference achieves the same result, a semi-solid emollient composition comprising jojoba oil

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6,8-15,17-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (U.S. Patent No. 4,286,609) in view of Arquette (U.S. Patent No. 5,968,530) and further in view of Nardolillo et al. (USPN 6,471,951B1).

Miller teaches a cuticle treatment composition known in the art for moisturizing the tissues surrounding the nail (see col.1, lines 21-35). Miller discloses using a bottle containing compositions for nail treatment which is known to be used as a hot oil treatment. Miller also teaches that the treatment involves using a cuticle stick which is cylindrical in shape (see col.2, lines 3-23). Miller teaches that the hot oil treatment uses

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a concentration of animal and vegetable oils, proteins, vitamins and other ingredients.

The animal and vegetable oils include corn, olive, cottonseed, sesame and coconut oils (see col.2, lines 24-37). Miller discloses a method for treating a cuticle using the emollients (see col.4, lines 32-63).

As for the teaching of extending the emollient composition past an opening in the container or extruding the emollient composition past the opening in the container, and replacing the cap on the container, one of ordinary skill in the art would know the suitable means to perform this function.

Miller does not particularly teach jojoba esters.

However, Arquette teaches an emollient composition which is used in cosmetic products, wherein the cosmetic products can be produced from fatty alcohols, isopropyl esters and wax esters, which can be obtained from jojoba oil. Arquette teaches jojoba wax esters (see col.4, lines 40-62). Arquette teaches that the emollient compositions may be used as emollient carriers (see col.7, lines 46-60). Arquette teaches fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks and sunscreens and insect repellants which may be combined with the emollient carrier (col.7, lines 46-60). Arquette discloses a process for making an emollient comprising the steps of a) providing a composition comprising jojoba oil, b) adding an alcohol to the said composition, c) effecting alcoholysis on said jojoba oil mixed with said alcohol to produce an emollient, and d) effecting interesterification of remaining wax esters (see col.8, lines 49-67, bridging col.9, lines 26).

Nardolillo is relied upon for the teaching of an eyebrow pencil containing wax bases such as jojoba wax, synthetic wax, including other traditional waxes, and fatty esters. Nardolillo teaches that the wax base composition typically contain an oil such as jojoba oil, which purpose is to soften the wax (see col.3, lines 23-54).

It would have obvious to one of ordinary skill in the art at the time the invention was made to modify the Miller reference, to include jojoba esters and to include a container that retains the semi-solid emollient taught by Arquette and Nardolillo, having the reasonable expectation of obtaining a semi-solid emollient composition which comprises jojoba esters, known for the purpose of treating the cuticles and for moisturizing the tissues surrounding the nails, and one expect to achieve similar beneficial results.

### ***Response to Arguments***

Applicant's arguments filed 3/3/05 have been fully considered but they are not persuasive. Applicant argues that quite simply, Kaplan does not teach or otherwise disclose a "cuticle treatment and conditioning composition", much less "a semi-solid emollient having esterified compounds at least partially derived from natural seed and nut oils". Irrespective of temperature ranges or additional compositional components, nowhere does Kaplan teach or disclose a "cuticle treatment and conditioning composition" in accordance with Applicant's claim 1 as amended. The combination of Arquette and Miller does not teach or suggest a "cuticle treatment and conditioning composition comprising a semi-solid emollient having esterified compounds as least partially derived from natural seed and nut oils" as set forth in claim 1 as amended.

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Additionally, there is no motivation or suggestion to be found in either the Arquette or the Miller reference, nor in the knowledge generally available to one of ordinary skill in the art, to modify Arquette or Miller or to combine either reference with each other, or any other reference of record, to practice the invention of claim 1 as amended.

Applicants submit that the combination of Arquette and Miller does not teach or suggest a "product for treating cuticles comprising a semi-solid emollient and a container that retains the semi-solid emollient and enables the user to apply the emollient to a selected surface without the user having to touch the emollient with his/her finger tips" as set forth in claim 10. Specifically, the combination of Arquette with Miller does not disclose, teach or otherwise suggest a "product for treating cuticles comprising a semi-solid emollient and a container that retains the semi-solid emollient and enables the user to apply the emollient to a selected surface without the user having to touch the emollient with his/her finger tips" (emphasis added).

In response to applicant's arguments, applicant is claiming a cosmetic composition and the specific use is a future-intended use. There is motivation for combining the references, because one of ordinary skill in the art would be able to determine the suitable forms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (571) 272-0596. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sharon Howard  
April 11, 2005

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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